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### **Remarks**

Reconsideration of this Application is respectfully requested.

Claims 1-3 and 11 are cancelled herein, claims 5-10, 12 and 13 are under consideration and claims 14-18 have been added, with claims 5, 8 and 14 being independent claims. Claim 4 was cancelled in the amendment filed February 8, 2004.

The Applicant acknowledges receipt of the Interview Summary of the interview of December 3, 2004, which was mailed on December 15, 2004.

The Applicant thanks the courtesy extended by Art Unit 3731 Supervisory Patent Examiner Anh Tuan Nguyen to the Applicant's representative in a telephone conversation on May 5, 2005.

The Applicant also notes the Examiner's notation that "both the Examiner and the Examiner's Primary did not find any allowable subject matter in the application," which was repeated from the Interview Summary mailed on December 15, 2004. The Applicant's representative hereby offers a concern that the Examiner has reached a conclusion about the allowability of any future claims without fully and objectively considering the Applicant's claims.

The Applicant is also concerned about the seemingly unnecessary amount of prosecution that has occurred in this case. Finality has been improperly imposed, then withdrawn on four (4) separate occasions: May 6, 2003; May 22, 2003; November 7, 2003 and September 8, 2004. Prosecution was also reopened after the Applicant filed a Notice of Appeal on July 19, 2004. The Examiner rendered moot most of the arguments made by the Applicant and thus the Examiner did not address the Applicant's arguments. As a result, the Applicant has been given little guidance as to what limitations in the claims would overcome the concerns of the

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Examiner. Also, multiple interviews, both in person and by telephone have taken place with Examiner Mendoza, Primary Examiner Dawson, and most recently on May 5, 2005, with Supervisory Patent Examiner Nguyen. At the advise of the Examiner in the Interview Summary of the October 28, 2003 telephonic interview, the Applicant inserted "oxygen mask" into the body of the claim 5 in the response filed February 8, 2004. Despite following the advice of the Examiner, the claims were inexplicably rejected in the Action mailed April 19, 2004. The Examiner's apparent rationale is based on his assertion that no structural limitations have been made for an oxygen mask and that any mask that could be used to breathe oxygen meets the limitations of the claims. Thus, with this belated rationale, the Examiner appears to have entirely changed the basis for rejection(s), and led to the Examiner's withdrawal of finality in the Action Mailed September 8, 2004.

The applicants respectfully request that prosecution in this matter be resolved, preferably by allowance. In the alternative, the applicants request that the rejections be placed in proper order so that an appeal can go forward.

In an effort to expedite prosecution, claims 13-18 have been added. The Applicant respectfully requests that the claims be carefully considered and that the Applicant's representative be contacted by telephone to discuss wording of the claims that would be acceptable to the Examiner. In the event that some of claims are found to be allowable, Applicants will be willing to cancel the non-allowable claims in favor of a continuing application.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

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### *Rejection of Claims under 35 U.S.C. 103(a)*

The Examiner considered moot the rejection of claims 1-3 and 5-10 in view of the new grounds for rejection. The Examiner had previously rejected the claims over Norfleet (U.S. Patent No. 6,418,929) in view of Dyrud et al. (U.S. Patent No. 5,819,731). The Examiner disagreed with the Applicant's argument that Norfleet teaches away from the Applicant's invention. The Examiner stated that the arrangement of the straps [of Norfleet] is to orient the mask in the proper position. The Examiner also stated that "a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim."

The applicants repeat their arguments set forth in their Reply filed December 8, 2004. Additionally, the Applicants point out that Dyrud et al. has been cited by the Examiner in various Office Actions dated June 5, 2002; May 6, 2003; May 22, 2003; April 19, 2004 and finally in the action mailed September 8, 2004. Applicant has offered repeated arguments that Dyrud et al. is not applicable as a secondary reference as used in combination with various primary references. However, as the Examiner repeatedly renders all previous rejections moot, the status of the rejections are understood by the Applicant to have been withdrawn.

The Examiner rejected claims 1-3 and 5-13 under 35 U.S.C. §103(a) as being unpatentable over Hudson (U.S. 2,843,121). The Examiner stated that Hudson teaches an oxygen mask 10 having a means for being secured over the nose and mouth of a patient comprising: and elastic band, points of attachment 15 on both sides of the mask, and the elastic band securable to the patient by pulling the ends anteriorally through the points of attachment" The Examiner also stated that Hudson fails to teach a pair of bands extendible to loop over and

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around each ear of the patient. The Examiner further stated that it would have been obvious to one of ordinary skill in the art to use ear loops as an alternative means of securing a mask and listed U.S. Patent Nos. 5,701,892 and 5,819,731 as supporting his assertions. The '731 patent by Dyrud et al. has been previously addressed by Applicants, and does not cure the deficiency of Hudson due to the requirement in Dyrud et al. to have a strap that goes around the back of the neck, as shown on the face of the patent. This requirement teaches away from the Applicant's invention. The '892 patent teaches a dust mask with ear loops, but does not teach an adjustable strap, as required by the present invention, and thus teaches away from the Applicant's invention.

The Examiner also stated that in regards to claims 2, 6, and 9, that Hudson failed to teach four points of attachment, but the Examiner stated that it would have been obvious to one of ordinary skill in the art to have four sets of attachment and cited *St. Regis Paper CO. v. Bemis Co.*, 193 USPQ 8, (549 F.2d 833(7th Cir. 1977) and cited, without comment, U.S. Patent Nos. 2,494,406, 2,798,483, 4,802,473, 4,942,470, 5,701,892, 5,813,398 and 6,394,090 to support his assertions. As the '406, '483, '473, '470, '892, '398 and '090 patents have been cited by the Examiner without comment, the Applicant cannot address the concerns of the Examiner when such concerns have not been articulated. The Applicant asserts that the combination of the '271 and '027 patents do not cure the deficiencies of Hudson. The Applicant also asserts that *St. Regis Paper Co. v. Bemis* does not support the statement of the Examiner that the Applicant's invention is merely "duplicating essential working parts of a device."

The Examiner also stated that the flap valve that was recited in claim 11-13 would have been obvious over Hudson and cited, without comment, U.S. Patent Nos. 4,098,271 and 4,865,027 as evidence to support his assertions. As the '271 and '027 patents have been cited by

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the Examiner without comment, the Applicant cannot address the concerns of the Examiner when such concerns have not been articulated. The Applicant asserts that the combination of the '271 and '027 patents do not cure the deficiencies of Hudson.

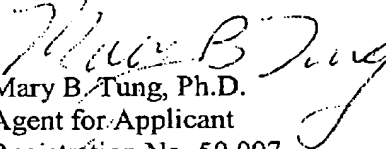
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### *Conclusion*

Claims 5-10 and 12-18 are under consideration by the Examiner. The subject matter of new claims 14-18 is found throughout the specification, in Figures 1 and 2, on page 3, lines 17-23, and by the original claims as filed. Thus, new matter is not introduced into the added claims. In view of the above remarks, Applicant respectfully submits that the application and claims are in condition for allowance, and request that the Examiner reconsider and withdraw the objections and rejections. Applicant believes that a full and complete reply has been made to the outstanding Office action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

  
Mary B. Tung, Ph.D.  
Agent for Applicant  
Registration No. 50,007

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CONWELL, LLC  
130 Lubrano Drive  
Suite 112  
Annapolis, Maryland 21401  
410-224-4546 (Phone)  
410-224-4748 (Fax)